

REMARKS

The Examiner rejected claims 11, 13-16 and 18 under 35 U.S.C. §101 because the cornea was positively recited in an apparatus claim. The applicant has amended claim 11 to remove recitation of the cornea in the body of the claim. The applicant therefore submits that the claims comply with §101.

The Examiner rejected claims 11, 14 and 18 under 35 U.S.C. §103(a) as being unpatentable over Doss, in combination with Wuchinich. Amended claim 11 recites a probe tip with a stop that limits the penetration depth of the tip. The Examiner has stated that element 42 of Doss is a stop. The applicant respectfully traverses this contention.

Element 42 of Doss is part of the probe housing 24. Claim 11 recites a power supply wherein a current flows through the probe into a ground element. Current does not flow through the housing 24 of the Doss probe. As stated on column 3, lines 65-66, the electrode housing 24 is “non-conductive”. In Doss, current flows from the electrode 20, through the saline solution and cornea, and into the electrode 36 shown in Figure 1 in the drawings. Doss does not disclose a probe from which current flows that has a stop which limits the penetration depth of a tip. Additionally, Wuchinich does not disclose this limitation. Consequently, the combination of Doss and Wuchinich do not disclose or suggests all of the limitations of independent claim 11. The applicant therefore submits that claims 11, 14 and 18 are patentably distinct over Doss and Wuchinich.

The Examiner rejected claims 20, 21 and 23 under 35 U.S.C. §103(a) as being unpatentable over Doss in view of Wuchinich. Independent claim 20 recites a probe that is in contact with a cornea wherein current flows from the probe and into the cornea. As already mentioned, element 42 of Doss is not an electrically conductive probe from which current flows to or from through the cornea. The combination of Wuchinich and Doss do

not disclose placing a probe in contact with the cornea and then transmitting a current from the probe, through the cornea and back through a ground element. For this reason the applicant submits that Doss and Wuchinich do not render unpatentable claims 20, 21 and 23.

The Examiner rejected claims 13, 15, 16 and 18 under 35 U.S.C. §103(a) as being unpatentable over Doss in view of Wuchinich and further in view of Schachar. The Examiner rejected claim 22 under 35 U.S.C. §103(a) as being unpatentable over Doss in combination with Wuchinich in further view of Schachar. The applicant has canceled claim 15. The applicant submits that claims 13, 16 and 18 are allowable for being dependent upon allowable independent claims.

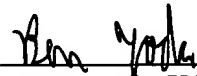
The applicant is enclosing a copy of a previously submitted IDS. The applicant has not received an indication that the Examiner has reviewed the references cited in the IDS. The applicant is enclosing again copies of the publications. The applicant requests that the Examiner consider the references cited in the IDS on the record.

In view of the above it is submitted that the claims are in condition for allowance. Reconsideration of the rejections is requested. Allowance of claims 11, 13, 14, 16, 18 and 20-23 at an early date is solicited.

Respectfully submitted,
IRELL & MANELLA LLP

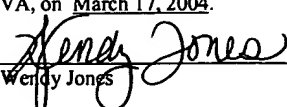
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840 Newport Center Drive, Suite 400
Newport Beach, CA 92660
949-760-0991


BEN J. YORKS
Reg. No. 33,609

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA, on March 17, 2004.


Wendy Jones
Date 3/17/04